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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/378,533

08/20/1999

PAMELA L. MCKISSICK

UV-98

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08/23/2004

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EXAMINER

SHELTON, BRIAN K

ART UNIT

PAPER NUMBER

2611

9

DATE MAILED: 08/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/378,533

Applicant(s)

MCKISSICK ET AL.

Examiner

Brian Shelton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 63-86 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 63-86 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 August 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This Action is in response to the Amendment received on 13 May 2004 (hereinafter "Amendment").
2. The Application has been examined. **Original claims 63-71 and Amended claims 72-86** are pending (the amendments are presented in response to an objection to misnumbered claims and present no substantive changes to the claim language). The objections and rejections are stated as below:

### *Response to Arguments*

3. Applicant's arguments filed 13 May 2004 have been fully considered but they are not persuasive.

In response to the Office Action, dated 13 February 2004 (hereinafter "First Action"), Applicants present an argument challenging the application of the Lawler reference in the rejection of independent claims 63, 69, 77, and 82. Claims 63, 69, 77, and 82 present limitations of "providing a user with the opportunity to select a program that will air outside a program listings time frame which is currently available to the user" and "providing a notification to the user of the availability of the selected program during when the selected program is now in the current program listings time frame." (see e.g., Amendment at page 2, claim 63).

By contrast, Applicants' argument contends that the Lawler reference is deficient in its disclosure because "[a]t no point is a user of Lawler's system *able to directly select a program that is not in the program schedule time frame as required by applicants' claims.*" (Amendment at page 11, lines 14-16) (emphasis added). However, as the analysis of the claim language of claims 63, 69, 77, and 82 makes clear, the limitation of *directly* selecting a program is not recited by the claim. As such, applicants' argument focuses on an attempt to distinguish the relied upon disclosure from the claim language by relying upon a feature which is not present in the claims. Thus, the argument fails to demonstrate a deficiency in Lawler's disclosure and is accordingly deemed non-persuasive. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The Examiner maintains the rejection of claims 63, 69, 77, and 82 was proper as anticipated by Lawler. To meet the limitation of "providing a user with the opportunity to select a program that will air outside a program listings time frame which is currently available to the user," Applicants were referred to col. 9, lines 44-48, col. 11, lines 53-61 and col. 12, lines 8-15 of Lawler (see e.g., First Action at page 10, line 20 – page 11, line 4). The relied upon sections meet the limitation because the "Every Week" feature of Lawler allows a user to select a program (i.e., episodes of a series that is broadcast every week) (see col. 11, lines 53-61) and furthermore, the episodes are necessarily "outside a program

listings time frame available to the user” since Lawler discloses a 2 week schedule listing (see col. 9, lines 44-48). Thus, selecting episodes of a weekly series necessarily involves selection of programs that are broadcast on the third week, the fourth week, the fifth week, and so on (e.g., outside the currently available listings time frame). Finally, Lawler discloses that the user is reminded each week until the reminder is removed by the user (see col. 12, lines 8-15).

As to the second limitation, the disclosure of Lawler additionally meets the limitation of “providing a notification to the user of the availability of the selected program when the selected program is now in the current listings time frame.” (see First Action at page 11, lines 5-8). Lawler, at col. 12, lines 44-47 discloses “conspicuously displayed” reminder panel that is displayed when the selected program is identified.

Accordingly, having demonstrated the rejection of claims 63, 69, 77, and 82 is fully supported by the disclosure of Lawler, and further, in considering Applicants’ arguments and finding them to be without merit, the rejection is maintained and Applicants’ request for allowance is denied.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 63, 66-68, 69-70, 74-76, 77, 79-81, 82, and 84-86** are rejected under 35 U.S.C. 102(e) as being anticipated by Lawler et al. (Lawler), U.S. Patent No. 5,699,107 (of record).

Regarding **independent claim 63**, Lawler discloses *a method for receiving notifications for upcoming programs, comprising:*

- (a) *providing a user with the opportunity to select a program that will air outside a program listings time frame which is currently available to the user (col. 9, lines 44-48 disclosing two-week future programming listings; col. 11, lines 53-61 discussing operation of Every Week button 146; col. 12, lines 8-15, describing automated reminding from week to week and continued operation until removed by user); and*
- (b) *providing a notification to the user of the availability of the selected program during when the selected program is now in the current program listings time frame (Fig. 9; col.12, lines 44-47; see also col. 13, lines 11-15 disclosing reminder icon displayed in program guide).*

As for **claim 66**, Lawler discloses *providing a notification comprising providing a message notification (Fig. 9; col.12, lines 44-47)*

As for **claim 67**, Lawler discloses *providing a notification comprising providing a reminder notification* (Fig. 9; col.12, lines 44-47; see also col. 13, lines 11-15 disclosing reminder icon displayed in program guide).

As for **claim 68**, Lawler discloses *providing the user with the opportunity to setup a configuration of the notification* (Fig. 8; col. 11, lines 40-67, wherein remind options menu includes options for This Show, Every Week, and Every Day).

Regarding **independent claim 69**, Lawler discloses *a program guide system* (Fig. 1; interactive viewing system **10**), *comprising:*

*User equipment (viewer stations 16) that is configured to provide a user with the opportunity to select a program that will air outside the program listings time frame which is currently available to the user* (col. 9, lines 44-48 disclosing two-week future programming listings; col. 11, lines 53-61 discussing operation of Every Week button **146**; col. 12, lines 8-15, describing automated reminding from week to week and continued operation until removed by user), *and is further configured to provide a notification to the user of the availability of the selected program when the selected program is now in the current program listings time frame* (Fig. 9;

col.12, lines 44-47; see also col. 13, lines 11-15 disclosing reminder icon displayed in program guide).

As for **claim 70**, Lawler discloses *the user equipment comprising user television equipment* (interactive station controller **18** with video display **20**; see col. 5, lines 57-65).

As for **claims 74 and 75**, Lawler discloses *the user equipment configured to provide a reminder notification* (Fig. **9**; col.12, lines 44-47 [disclosure of reminder notification discloses the “message notification” limitation of claim 74]; see also col. 13, lines 11-15 disclosing reminder icon displayed in program guide).

As for **claim 76**, Lawler discloses *user equipment configured to provide the user with the opportunity to setup a configuration of the notification* (Fig. **8**; col. 11, lines 40-67, wherein remind options menu includes options for This Show, Every Week, and Every Day).

Regarding **independent claim 77**, Lawler discloses, *in user television equipment* (viewer stations **16**), *a method for receiving notifications for upcoming programs* (col. 3, lines 41-47), *comprising*:



- (a) *providing a user with the opportunity to specify a program that will air outside a current program listings time frame of user television equipment* (col. 9, lines 44-48 disclosing two-week future programming listings; col. 11, lines 53-61 discussing operation of Every Week button **146**; col. 12, lines 8-15, describing automated reminding from week to week and continued operation until removed by user); *and*
- (b) *displaying a notification of the availability of the selected program during when the selected program is now in the current program listings time frame of the user television equipment* (Fig. **9**; col.12, lines 44-47; see also col. 13, lines 11-15 disclosing reminder icon displayed in program guide).

As for **claim 79**, Lawler discloses *displaying including displaying a message notification* (Fig. **9**; col.12, lines 44-47).

As for **claim 80**, Lawler discloses *displaying including displaying a reminder notification* (Fig. **9**; col.12, lines 44-47; see also col. 13, lines 11-15 disclosing reminder icon displayed in program guide).

As for **claim 81**, Lawler discloses *providing the user with the opportunity to setup a configuration of the notification* (Fig. **8**; col. 11, lines 40-67, wherein

remind options menu includes options for This Show, Every Week, and Every Day).

Regarding **independent claim 82**, Lawler discloses *a program guide system (Fig. 1; interactive viewing system 10), comprising user television equipment (viewer stations 16) that is configured to provide a user with the opportunity to select a program that will air outside the current program listings time frame of the user television equipment (col. 9, lines 44-48 disclosing two-week future programming listings; col. 11, lines 53-61 discussing operation of Every Week button 146; col. 12, lines 8-15, describing automated reminding from week to week and continued operation until removed by user), and is further configured to display a notification of the availability of the selected program when the selected program is now in the current program listings time frame of the user television equipment (Fig. 9; col.12, lines 44-47; see also col. 13, lines 11-15 disclosing reminder icon displayed in program guide).*

As for **claim 84**, Lawler discloses *user television equipment configured to display a message notification (Fig. 9; col.12, lines 44-47).*

As for **claim 85**, Lawler discloses *user television equipment configured to display a reminder notification (Fig. 9; col.12, lines 44-47; see also col. 13, lines 11-15 disclosing reminder icon displayed in program guide).*

As for **claim 86**, Lawler discloses *user television equipment configured to provide the user with the opportunity to setup a configuration of the notification* (Fig. 8; col. 11, lines 40-67, wherein remind options menu includes options for This Show, Every Week, and Every Day).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 64, 65, 72, 73, 78 and 83** are rejected under 35 U.S.C. 103(a) as being unpatentable over Lawler et al. (Lawler), U.S. Patent No. 5,699,107 in view of Boyer et al. (Boyer), U.S. Patent Publication No. US 2002/0026496 (of record).

The limitation of **claims 65 and 73** is encompassed by the teachings of Lawler in view of Boyer (see discussion of applicants' claims 9 and 45, supra). Specifically, Boyer discloses *providing a notification including providing an e-mail notification* (Fig. 6; page 4, paragraph 51).

Regarding **claims 64, 72, 78, and 83**, Lawler is relied upon for the disclosure as discussed above. Although Lawler discloses a programming guide wherein programming selected for a reminder is displayed with a reminder icon in the programming listings (col. 13, lines 11-16), Lawler does not specifically disclose a view current notifications options which provides a list of current notification orders.

Boyer, though, in the same field of endeavor, discloses means for providing a view current notifications option which the user selects to receive a list of current notification orders (Fig. 7; current reminders page 710; page 4, paragraph 52) for the advantage of simplifying the display of multiple reminders in a television programming reminder system.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Lawler to include *means for providing a view current notifications options which the user selects to receive a list of current notification orders*, as taught by Boyer, for the advantage of simplifying the display of multiple reminders in a television programming reminder system.

8. **Claim 71** is rejected under 35 U.S.C. 103(a) as being unpatentable over Lawler et al. (Lawler), U.S. Patent No. 5,699,107 in view of Knee et al. (Knee), U.S. Patent No. 5,589,892 (of record).

Regarding **claim 71**, Lawler is relied upon for the teachings as discussed above relative to claim 69. Lawler fails to specifically disclose user equipment comprising personal computer equipment.

However, Knee, in the same field of endeavor, discloses an EPG system wherein the user equipment is personal computer equipment (col. 9, lines 50-58; see also col. 11, line 66 – col. 12, line 3) for the advantage of integrating PC (personal computer) functions (e.g., data processing, video games, internet access) with television programming selection and viewing.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Lawler to include *user equipment comprising personal computer equipment*, as taught by Knee, for the advantage of integrating PC (personal computer) functions (e.g., data processing, video games, internet access) with television programming selection and viewing.

### **Conclusion**

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

### **Certificate of Mailing**

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Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Shelton whose telephone number is (703) 305-8714. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on (703) 305-4755. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Brian Shelton  
Examiner  
Art Unit 2611

BS

  
CHRIS GRANT  
PRIMARY EXAMINER